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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,991	10/13/2005	Yoshiaki Sato	SUZ0022-US	5832
36183 7590 06/10/2010 PAUL, HASTINGS, JANOFSKY & WALKER LLP 875 15th Street, NW Washington, DC 20005				
EXAMINER				
BACHMAN, LINDSEY MICHELLE				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
06/10/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/552,991

**Applicant(s)**

SATO, YOSHIAKI

**Examiner**

LINDSEY BACHMAN

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 5, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Interval Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 5-29-09

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 December 2009 has been entered.

***Response to Arguments***

Applicant's arguments regarding Claims 1 and 8 filed 14 December 2009 have been fully considered but they are not persuasive.

Regarding the rejection to Claim 1, Applicant argues that Newton does not need to be modified with the additional reinforcing sheet from Kawasaki since Newton already has wire-like pieces for reinforcement. Examiner agrees that the invention of Newton does not require an additional reinforcing sheet. However, the 103 rejection is showing that it would be obvious to attach Newton's reinforcing member (wire-like pieces 4) to the band with either two-sided tape or sewing, since Kawasaki teaches attaching a similar reinforcing member (element 13) to the band with these methods. Kawasaki's statement that that either attachment method can be used shows that the two methods attachment methods are interchangeable or one attachment method can be substituted for

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another. Thus, it would be obvious to one of ordinary skill in the art to substitute the attachment method of Newton (sewing) with the attachment method of Kawasaki (two-sided tape).

Applicant's arguments with respect to claims 5 and 9 have been considered but are moot in view of the new ground(s) of rejection below.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the inner surface" and "the outer segment" in third last line of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newton (US 2,332,488) in view of Kawasaki et al. (US 5,433,724).**

Newton teaches a muscle development device comprising: a hollow tight fitting band (1) having a tube (14) and a plurality of wire-like pieces (4) provided therein; fastening means (10) for use in keeping a length of the tight fitting band in a loop having a desired size (column 2, lines 16-19). The wire-like piece is designed to limit the direction towards which said tube is allowed to inflate as said tube is filled with air, to against the muscles as determined with said tight fitting band being rest on the muscles (column 2, lines 5-8, 46-48). The wire-like pieces are placed in a direction perpendicular to the lengthwise direction of the band (Figure 1 or 2, for example). The wire-like pieces are located on the inner surface of the outer segment of the band opposite to the muscles and just outside the tube (column 1, line 45 to column 2, line 14). Newton does not attach the wire-like pieces with a stretchable seam tape, but instead teaches that the wire-like pieces are stitched into place on the outer segment of said tight fitting band (column 2, lines 30-38).

Kawasaki et al. disclose a tight fitting band wherein reinforcing member (13) is attached to the tight fitting band by either two surface tape or sewing (column 9, lines 35-45). It would have been obvious to one of ordinary skill in the art to alternatively attach the wire-like reinforcement pieces of Newton with tape rather than stitching since taping and sewing the reinforcement means to the band are equivalent as taught by Kawasaki. Substitution of one known element

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for another element providing the same function to yield predictable results would have been obvious to one of ordinary skill in the art at the time of the invention.

**Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eaton (US Patent 5,413,582).**

Eaton'582 discloses a device that contains a hollow tight fitting band (20) having a tube (38) therein and fastening means (74) to keep the length of the band in a loop of a desired size (column 4, lines 51-53). Pressure in the band is produced by introducing air to the tube. The band has a higher stretching rate on the side facing the muscles than on the side opposite to the muscles, as determined with said tight fitting band resting on the muscles, said tube being designed to inflate more in a direction against the muscles than in a direction away from the muscles as said tube is filled with air with said tight fitting band being rest on the muscles (column 4, line 65 to column 5, line 21). Eaton further discloses a seam tape (66) that is located on the tube on a side opposite to the muscles. Since Eaton discloses that the outer surface of the tube expands slower than slower than the inner surface of the tube, and the tape (66) is attached to the outer surface, it would be obvious that the stretching rate of the tape is less than the stretching rate of the tube.

**Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Newton'488 in view of Kawasaki'724, as applied to claim 1 above, further in view of Nagelman (US 1,288,130).**

Newton'488 in view of Kawasaki'724 discloses the claimed invention except for an air limiting means that delimits the portion of said tube into which

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air is allowed to enter when attached to said tight fitting band at a certain position along the length thereof.

Nagelman discloses a clamp (15, 17) that delimits the portion of a tube into which air is allowed to enter when attached to a tight fitting band (Fig. 1). It would have been obvious to one of ordinary skill in the art to provide a clamp or "air limiting means", as taught by Nagelman, in the device of Newton in order to prevent air from entering the tube until the desired time.

**Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eaton'582, as applied to claim 5 above, further in view of Nagelman'130.**

Eaton discloses the claimed invention except for an air limiting means that delimits the portion of said tube into which air is allowed to enter when attached to said tight fitting band at a certain position along the length thereof.

Nagelman discloses a clamp (15, 17) that delimits the portion of a tube into which air is allowed to enter when attached to a tight fitting band (Fig. 1). It would have been obvious to one of ordinary skill in the art to provide a clamp or "air limiting means", as taught by Nagelman, in the device of Eaton in order to prevent air from entering the tube until the desired time.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSEY BACHMAN whose telephone number is (571)272-6208. The examiner can normally be reached on Monday to Thursday 7:30 am to 5 pm, and alternating Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. B./  
Examiner, Art Unit 3734

/TODD E. MANAHAN/

Supervisory Patent Examiner, Art Unit 3734